

**REMARKS****I. General**

Claims 26 and 29 – 39 are presently pending in the application. After entry of this amendment, claims 26, 29 – 39 and 48 will be pending in the application. The issues in the current Office Action are as follows:

- The Examiner has objected to claims 32 and 36.
- The Examiner has rejected claims 26, 29 – 32, 35, 36 and 39, under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,148,232 to Avrahami (hereinafter “Avrahami”).
- The Examiner has rejected claim 33, under 35 U.S.C. § 103(a), as being unpatentable over Avrahami, as applied to claim 29, and further in view of U.S. Patent Publication No. 2002/0173743 to Tapper (hereinafter “Tapper”).
- The Examiner has rejected claims 37 and 38, under 35 U.S.C. § 103(a), as being unpatentable over Avrahami, as applied to claim 36, and further in view of U.S. Patent No. 5,860,957 to Jacobsen (hereinafter “Jacobsen”).

The Applicant thanks the Examiner for the courtesy and professionalism shown thus far. The Applicant hereby traverses the rejections and requests reconsideration and withdrawal in light of the amendments and remarks contained herein.

**II. Claim Objections**

Claims 32 and 36 are objected to because of informalities. Claims 32 and 36 have been amended so as to overcome the Examiner’s objections. The amendments affected only style and spelling preferences. No new matter was added.

**III. Claim Amendments**

In addition to claims 32 and 36, claim 29 has been amended to remove the limitation regarding constantly varying the frequency of the alternating current. New claim 48 now

recites this limitation. Claim 29 has also been amended to recite “the device comprising” to make the claim clearer. Support for this amendment may be found at least at page 4, lines 13 – 18 of the specification. No new matter has been added by these amendments.

#### **IV. Claim Rejections**

##### **A. 35 U.S.C. § 103(a) Rejections**

The Examiner has rejected claims 26 and 29 – 39, under 35 U.S.C. § 103(a), as being obvious over Avrahami. The question of obviousness is resolved on the basis of factual inquiries including: (1) scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 15 - 17 (1966). The Applicant discusses the obviousness rejections below.

##### **1. 35 U.S.C. § 103(a) Rejection over Avrahami**

The Examiner has rejected claims 26, 29 – 32, 35, 36 and 39, under 35 U.S.C. § 103(a), as being unpatentable over Avrahami. The Examiner asserts that a combination of the device depicted by Avrahami, Figure 7 and the device depicted by Avrahami, Figure 1A renders the claims obvious. Avrahami, however, does not teach all the limitations of the rejected claims. The Applicant discusses some of these limitations below.

##### **a. Independent claim 29**

Claim 29, requires, “a dressing for applying to a treatment area . . . .” The Examiner concedes that Avrahami, Figure 7 does not teach this limitation of claim 29 and consequently, relies on Avrahami, Figure 1A for teaching this limitation. Office Action, page 4. Specifically, the Examiner asserts that skin patch 40 in Avrahami, Figure 1A is a dressing. A claim term, however, must be given “its ordinary and customary meaning to one of ordinary skill in the art.” *Phillips v. AWH Corp.*, F.3d, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc). The Applicant submits that one skilled in the art would not consider that skin patch 40 teaches a dressing. For example, the specification of the current application provides that: “Dressings for promoting tissue repair have been known for many years.” Current Specification, paragraph [0007]. One skilled in the art, having read Avrahami, would not

consider the device of Avrahami, Figure 1A, including skin patch 40, as promoting tissue repair. To the contrary, the devices in Avrahami are directed to ablation (removal) of the stratum corneum epidermis (outermost layer of the skin) and creating channels through the stratum corneum for transdermal drug delivery and analyte extraction. Abstract; col. 1, lines 5 – 9. Ablating tissue and creating channels through tissue does not teach the promotion of tissue repair. Therefore, one skilled in the art would not consider that the device of Avrahami, Figure 1A, including skin patch 40, teaches a dressing. As such, the combination of Avrahami, Figure 7 and Avrahami, Figure 1A does not teach “a dressing for applying to a treatment area . . . .”

Claim 29, as amended, also requires, “a control unit . . . for constantly varying the amplitude.” The Examiner relies on col. 9, lines 1 – 4 for teaching the control unit of claim 29. The cited portion of Avrahami, however, does not disclose a control unit for constantly varying the amplitude. Moreover, based on Applicant’s review, it does not appear that any portion of Avrahami teaches this limitation. In sum, Avrahami does not teach all the limitations of claim 29. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claim 29.

**b. Dependent claims 26 and 30 – 32, 35, 36 and 39**

Dependent claims 26 and 30 – 32, 35, 36 and 39 depend either directly or indirectly from independent claim 29 and thus inherit all the limitations of claim 29. It is respectfully submitted that dependent claims 26 and 30 – 32, 35, 36 and 39 are allowable at least because of their dependence from claim 29 for the reasons discussed above. Additionally, the dependent claims themselves recite limitations that the Examiner has not shown to be taught by the applied reference. The Applicant discusses some of these limitations below.

**1. Claim 30**

Claim 30 requires, “A device according to claim 29, wherein the alternating current is varied between 50 and 500 microamps.” The Examiner concedes that “Avrahami is silent about whether the alternating current is varied between 50 and 500 mircoamps.” To address this conceded deficiency, the Examiner concludes that “it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the

alternating current to be varied between 50 and 500 microamps . . . .” Office Action, page 5. Additionally, the Examiner asserts that the basis for this conclusion is that “it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges (current range) involves only routine skill in the art.” *Id.*

The Examiner’s assertion about routine skill, however, does not establish that the applied reference renders claim 30 obvious. Indeed, assertions about routine skill do not negative patentability:

[W]e do not agree that ‘routine experimentation’ negatives patentability. The last sentence of section 103 states that ‘patentability shall not be negated by the manner in which the invention was made.’ To support the board’s decision that ‘routine experimentation within the teachings of the art’ will defeat patentability requires a primary determination of whether or not appellants’ experimentation comes within the teachings of the art. **Whether the subsequent experimentation is termed ‘routine’ or not is of no consequence.**

*In Re Fay*, 347 F.2d 597 (C.C.P.A. 1965) (emphasis added). In the present case, the Examiner’s assertions that the limitation recited in claim 30 represents discovering the optimum or workable range and involves only routine skill in the art does not address the question of obviousness of claim 30.

In sum, the Examiner has not shown that the applied reference teaches the limitations of claim 30 or that the reference renders claim 30 obvious.

## 2. Claim 32

Claim 32 requires, “A device according to claim 29, wherein the time period between each variation of amplitude and/or frequency is 0.1 s. The Examiner conceded that “Avrahami is silent about whether the time period between each variation of amplitude an/or frequency is 0.1 s.” Office Action, page 5. To address this conceded deficiency, the Examiner concludes that “it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the time period between each variation of amplitude an/or frequency is 0.1 s . . . .” Office Action, page 5. Additionally, the Examiner

asserts that the basis for this conclusion is that “it has been held that discovering the optimum value of a result effective variable (time period) involves only routine skill in the art.” *Id.*

The Examiner’s assertion about routine skill, however, does not establish that the applied reference renders claim 32 obvious. As noted above, assertions about routine skill do not negative patentability. In the present case, the Examiner’s assertions that the limitation recited in claim 32 represents discovering the optimum value of a result effective variable involves only routine skill in the art does not address the question of obviousness of claim 32. In sum, the Examiner has not shown that the applied reference teaches the limitations of claim 32 or that the reference renders claim 32 obvious.

### **3. Claim 39**

Claim 39 requires, “the electronic circuitry detects when a current can pass between the activation electrodes and only supplies current to the output electrodes when the tab is removed such that no current passes between the activation electrodes.” The Examiner has not even discussed this limitation of claim 39. Instead, the Examiner merely attempts to show that Avrahami teaches a pair of activation electrodes and a removable tab. *See* Office Action, page 7. Therefore, the Examiner has not shown that the applied reference teaches all the limitations of claim 39.

### **4. Summary regarding dependent claims 26 and 30 – 32, 35, 36 and 39**

In sum, the Examiner has not shown that the applied reference teaches all the limitations of or renders dependent claims 26 and 30 – 32, 35, 36 and 39 obvious. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claims 26 and 30 – 32, 35, 36 and 39.

### **2. 35 U.S.C. § 103(a) Rejection over Avrahami in view of Tapper**

Claim 33 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Avrahami, as applied to claim 29, and further in view of Tapper. Dependent claim 33 depends from independent claim 29 and thus inherits all the limitations of claim 29. The Examiner does not rely on Tapper for teaching the limitations of claim 29 discussed above nor does it appear that

Tapper teaches these limitations. It is respectfully submitted that dependent claim 33 is allowable at least because of its dependence from claim 29 for the reasons discussed above. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claim 33.

**3. 35 U.S.C. § 103(a) Rejection over Avrahami in view of Jacobsen**

Claims 37 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Avrahami, as applied to claim 36, and further in view of Jacobsen. Dependent claims 37 and 38 depend from independent claim 29 and thus inherit all the limitations of claim 29. The Examiner does not rely on Jacobsen for teaching the limitations of claim 29 discussed above nor does it appear that Jacobsen teaches these limitations. It is respectfully submitted that dependent claims 37 and 38 are allowable at least because of their dependence from claim 29 for the reasons discussed above. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claims 37 and 38.

**V. New Claim 48**

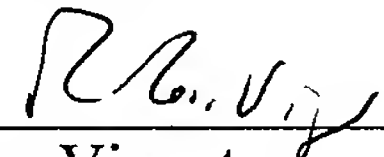
Dependent claim 48 depends from independent claim 29 and thus inherits all the limitations of claim 29. The Examiner does not rely on Tapper or Jacobsen for teaching the limitations of claim 29 discussed above nor does it appear that Tapper or Jacobsen teaches these limitations. It is respectfully submitted that dependent claim 48 is allowable at least because of its dependence from claim 29 for the reasons discussed above.

**VI. Conclusion**

In view of the above, the Applicant believes the pending application is in condition for allowance. The Applicant believes no fee is due with this response. Please charge any fees required or credit any overpayment to Deposit Account No. 06-2380, under Order No. 51407/P029US/10605267 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: November 11, 2009

Respectfully submitted,

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